UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,545	06/18/2001	Takeshi Fujita	450131-03247	1281

20999	7590	02/10/2004

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER
ZHOU, TING

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *18 June 2001* is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☒ Some *   c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

     a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Drawings

1.   The drawings are objected to because the following reference characters are not labeled

in an appropriate descriptive manner: reference characters 10, 23, 33 and 37-39 in Figure 1;

reference characters 23, 202-205 and 302 in Figure 2; reference characters 401-405 in Figure 4;

and reference character "404" in Figures 11, 12 and 13.

2.   Applicant is required to submit a proposed drawing correction of the above noted

deficiencies in reply to this Office action. However, formal correction of the noted defect may

be deferred until after the examiner has considered the proposed drawing correction. Failure to

timely submit the proposed drawing correction will result in the abandonment of the application.

Specification

3.   Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a

separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed

150 words in length since the space provided for the abstract on the computer tape used by the

printer is limited. The form and legal phraseology often used in patent claims, such as "means"

and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist

readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the

title. It should avoid using phrases which can be implied, such as, "The disclosure concerns,"

"The disclosure defined by this invention," "The disclosure describes," etc.

The abstract is objected to because it contains two paragraphs and the abstract of the

discloser should be limited to a single paragraph.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

4.   Claims 1-3 and 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The use of "and/or" throughout the claims renders the claims

indefinite as improper alternative limitations. It is suggested that the applicant change the claim

format from "A, B and/or C" to -- at least one of A, B and C --.

5.   Claims 2, 4, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. The numerous grammar inconsistencies throughout the claims renders the claims

indefinite because the meaning of the limitations are unclear. Some examples of such

grammatical inconsistencies are given below:

     a.   claim 2: "an image file including an area for recording data which influences on a

view of an image and an area for recording data which does not influence on the view of

the image". It is unclear what is meant by an area which does influence on a view of the

image and an area which does not influence on a view of the image.

     b.   claim 4: "a pointer for at least information and handling of information indicated

by the pointer are dealt as one pair". It is unclear how a pointer can be one pair.

     c.   claim 8: "executing a file existing in a predetermined pointer". It is unclear how a

file exists in a pointer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

6.   Claims 1-17 and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoyle

U.S. Patent 6,141,010.

Referring to claim 1, Hoyle teaches a computer readable recording medium (computer

readable apparatus and memory recited in column 4, lines 53-57) on which an image (banner

images) is recorded, wherein, in a data stream of the image file, identification information

inherent to the image file, pointers of one or a plurality of information, an index of a menu item

corresponding to the image file and/or an entity of a predetermined program are recorded (in the

banner database, information such as the image file names representing identification

information inherent to the image file, destination link pointers to websites, an index or table of

menu item information corresponding to the image file and an entity of a predetermined program

such as priory level or associated image file programs are recorded), as recited in column 14,

lines 59-67 and column 15, lines 1-6. This is further shown in Figure 7.

Referring to claim 2, Hoyle teaches a computer readable recording medium (computer

readable apparatus and memory recited in column 4, lines 53-57) on which an image file

including an area for recording data which influences on a view of an image (second program

module or advertising program module ADM which selects information to be displayed in the

display area) and an area for recording data which does not influence on the view of the image

(first program module which displays a graphical user interface comprising a display area for

displaying selected images), wherein, in the area for recording data which does not influence on

the view of the image, identification information inherent to the image file, pointers of one or a

plurality of information and/or an entity of a predetermined program are recorded (the interface

stores information related to the displayed image files, such as image file names representing

identification information inherent to the image file, destination link pointers to websites, an

index or table of menu item information corresponding to the image file and an entity of a

predetermined program such as priory level or associated image file programs), as recited in

column 4, lines 19-46, column 14, lines 59-67 and column 15, lines 1-6. This can further be seen

from Figures 5 and 5a.

Referring to claim 3, Hoyle teaches a computer readable recording medium (computer

readable apparatus and memory recited in column 4, lines 53-57) on which an image file

(banner) is recorded, wherein, in a data stream of the image file, on an area which is ignored

when displaying the image (banner database stored in memory), identification information

inherent to the image file, pointers of one or a plurality of information, an index of a menu item

corresponding to the image file and/or an entity of a predetermined program are recorded (in the

banner database, which is ignored, or not shown to the user when displaying the banner,

information such as the image file names representing identification information inherent to the

image file, destination link pointers to websites, an index or table of menu item information

corresponding to the image file and an entity of a predetermined program such as priory level or

associated image file programs are recorded), as recited in column 14, lines 59-67 and column

15, lines 1-6. This is further shown in Figure 7.

Referring to claim 4, Hoyle teaches a computer readable recording medium (computer

readable apparatus and memory recited in column 4, lines 53-57) on which an image file

(banner) is recorded, wherein, in a data stream of the image file, a pointer for at least information

(destination link of banner) and handling of information (according to priority level) indicated by

the pointer are dealt as one pair so that one pair or a plurality of pairs of them are recorded (the

destination link associated with the banner and the handling of the destination link according to

its priority level are all associated with and recorded in one row of the banner database and one

image file), as shown in Figure 7.

Referring to claim 5, Hoyle teaches recording means on which an image file is recorded

(storing banner images in the database) (column 14, lines 59-60), input means for inputting

pointers of one or a plurality of information, an index for a menu item corresponding to the

image file and/or identification information of an entity of a predetermined program (input

means such as keyboard and mouse are used to input information such as pointers, or URL of the

desired webpage) (column 7, lines 17-18 and column 9, lines 49-52) and information processing

means for recording, in a data stream of the image file, the pointer of the information input from

the input means, the index of the menu items corresponding to the image file and/or the entity of

the program corresponding to the identification information (storing statistical data regarding the

display of the selected information, such as the pointer or destination URL of the selected image

file, according to user interaction with the computer) (column 4, lines 41-46, column 9, lines 52-

57 and column 14, lines 59-67).

Referring to claim 6, Hoyle teaches a medium on which an image file creation program

(the GUI module and ADM module shown in Figure 2) is recorded which causes a computer to

execute the steps of accepting, from input means, inputs of pointers of one or a plurality of

information, an index for a menu item corresponding to the image file and/or identification

information of an entity of a predetermined program (inputting the URLs or path and file names

of desired web pages via inputting means such as a keyboard and mouse) (column 7, lines 17-18

and column 9, lines 49-52), and recording, in a data stream of an image file stored in memory

means, the pointers of the information input from the input means, the index of the menu items

corresponding to the image file and/or the entity of the program corresponding to the

identification information (storing, or recording the destination path or file names in the banner

database stored in memory) (column 14, lines 59-67 and column 15, lines 1-6).

Referring to claim 7, Hoyle teaches a medium on which an image file, comprising a

recording medium according to claims 1, 2, 3 or 4 (computer readable apparatus and memory

recited in column 4, lines 53-57 and column 14, lines 59-67), and information processing means

for reading out the image file from the recording medium in response to a request from a

terminal device and returning it to the terminal device (displaying the image file, or destination

banner/URL in response to user interaction with the computer), as recited in column 5, lines 48-

67 and column 9, lines 49-57.

Referring to claim 8, Hoyle teaches a medium for recording an image file processing

program (the GUI module and ADM module shown in Figure 2) in order to cause a computer to

execute the steps of monitoring an access to an information image file managed in a first

managing area (the first program module which contains user selectable links to information

sources), when there is an access to the information image file managed in the first managing

area, displaying, on a second managing area, an image based on image related information

included in the information image file and managing the information image file on the second

managing area, monitoring an access to an information image file managed in the second

managing area (when the user selects a link from the first program module, the user is given

access to its information resources and the second program module is notified of the user

selection and consequently manages and selects the informational data to be displayed), and

when there is an access to the information image file managed in the second managing area,

accessing to and executing a file existing in a predetermined pointer or a corresponding file

stored in advance on a local recording medium (upon selection of the informational data to be

displayed, the second program module accesses and executes/displays the image file stored in the

database), as recited in column 4, lines 19-49.

Referring to claim 9, Hoyle teaches an access to an information image file managed in

the first managing area being a drag and drop operation for a corresponding image, as recited in

column 10, lines 11-18.

Referring to claim 10, Hoyle teaches an access to an information image file managed in

the first managing area being a selection operation for a menu displayed with respect to the

corresponding image, as recited in column 9, lines 39-44 and further shown by reference

character "70" in Figure 5.

Referring to claim 11, Hoyle teaches an access to an information image file managed in

the first managing area being a drag and drop operation for a menu (drag and drop operations for

adding or removing buttons on the toolbar menu) displayed with respect to a corresponding

information image file, as recited in column 11, lines 21-29.

Referring to claim 12, Hoyle teaches an access to an information image file managed in

the first managing area being a click operation for a corresponding image, as recited in column 9,

lines 57-59 and column 15, lines 3-6.

Referring to claim 13, Hoyle teaches an access to an information image file managed in

the first managing area being a drag and drop operation for a corresponding information image

file, as recited in column 10, lines 11-18.

Referring to claim 14, Hoyle teaches a medium for recording an image file processing

program for causing a computer to execute the steps of (the GUI module and ADM module

shown in Figure 2), when a recording medium in a first managing area can be accessed,

searching an information image file from the recording medium, and, when the information

image file is searched, reading out the information image file and managing it in a second

managing area (when the user activates a link in the first program module, it is determined, via

searching for example, whether the link belongs to one of a plurality of data sets and when the

second program module is notified that the selection of the link, the second program module then

takes over control in selecting and displaying informational data), as recited in column 4, lines

19-49.

Referring to claim 15, Hoyle teaches the first managing area being a window for viewing

a web page of a WWW browser, a window for viewing a body of e-mail software, a window for

checking an attached file of e-mail software, a folder window for referring a file stored on a

recording medium, or a window which is displayed by operating input means for an image or an

image file (the first managing area displays a graphical user interface comprising a window

capable of displaying links to different information sources, such as WWW pages or image files

such as banners), as recited in column 4, lines 22-35.

Referring to claim 16, Hoyle teaches an image file processing device (computer readable

apparatus in column 4, lines 53-57) comprising information processing means for storing a menu

item corresponding to an image on memory means (banner storage means for storing the table, or

menu of banner image file data, as shown in Figure 7), when a predetermined image is selected

from input means (user clicks on link or banner), reading out a menu item corresponding to the

selected image from memory means in order to display it on the display means, and, when the

displayed menu item is selected through the input means, performing predetermined processing

corresponding to the selected menu item, wherein the information processing means accesses to

an outside server device (ADM server) to obtain a menu item corresponding to the image and

stores it on the memory means (when the user selects a banner or link, the menu or table of

image file information associated with the link or banner is shown and the user can further

process the data by selecting for example, one of the associated links corresponding to the banner

image), as recited in column 22, lines 46-67 and column 23, lines 1-40. This can also be seen in

Figures 1, 2, 4 and 7.

Referring to claim 17, Hoyle teaches the first managing area and second managing area

formed and managed by independent programs (the first managing area is formed and managed

by the first program module, or GUI module and the second managing area is formed and

managed by the second program module, or the ADM module), as recited in column 4, lines 19-

50 and column 6, lines 62-65.

Referring to claim 19, Hoyle teaches a view of the first managing area and a view of the

second managing area displayed simultaneously with a frame, as shown in Figures 5 and 5a,

where the area for displaying ads is shown in the same window, or frame, as the GUI containing

the menu item icons for manipulating the interface display.

Referring to claim 20, Hoyle teaches when an access is made to an information image

file managed in a first markup description language file which is a first managing area, a second

markup description language file which is a second managing area is read out from memory

means, and, after the second markup description language file is updated so that the second

markup description language file manages the information image file, the second markup

description language file is executed (when the user selection of a link in the first program

module is detected, the second program module is operable to select and display the

informational data), as recited in column 4, lines 19-49.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle U.S.

Patent 6,141,010, as applied to claims 8 and 17 above, and further in view of Shaw et al. U.S.

Patent 5,809,242.

Referring to claim 18, while Hoyle teaches all of the limitations as applied to claims 8

and 17 above, he fails to teach view selection tabs for selecting one of views of a first managing

area and a view of a second managing area. Shaw et al. teach an image file (banner) processing

device similar to that of Hoyle. In addition, Shaw et al. teach displaying view selection tabs for

selecting one of views of a first managing area (first managing area tab for reading emails) and a

view of a second managing area (second managing area tab for writing emails) in order to

display selectively the managing area at a side of a tab selected through input means, as recited

in column 16, lines 66-67 and continuing onto column 17, lines 1-19, and further shown in

Figure 8. It would have been obvious to one of ordinary skill in the art, having the teachings of

Hoyle and Shaw et al. before him at the time the invention was made, to modify the image file

processing system of Hoyle to include the use of selection tabs taught by Shaw et al. It would

have been advantageous to make such a combination in order to better organize the display of

information shown to the user; separating information categories into groups and displaying

them in separate tabs will allow the users to see all the functions and information relating to one

group, without getting confused by the cluttered display of mixed information from multiple

groups.

8.   The prior art made of record on form PTO-892 and not relied upon is considered

pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider

these references fully when responding to this action. The documents cited therein teach similar

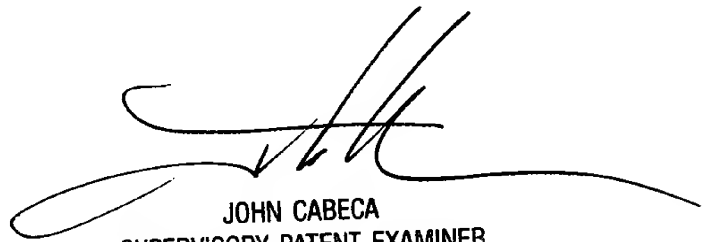methods and systems for managing and displaying image file information, such as banners.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703) 305-0328. The examiner can normally be reached on Monday-Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on 703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

February 5, 2004

JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100